

juxtaposed with that area of the TV screen, so that the signals can be detected. If the TV program is recorded, the injected signals are recorded with the program, so that when the program is played back from the recorder 26, the signals are detected and the information described above can be supplied via modem 6 "to a centralized evaluator" (col. 4, line 8). In the embodiment illustrated in Fig. 3, "a channel identification code and a program code" (col. 5, lines 54-55) are injected into a TV program prior to broadcast and thus, only the signal detector 8, 9, modem 6 and processors 12, 15 are required at the location of the TV set 3.

Rejection under 35 U.S. C. § 102(b)

In item 2 on page 2 of the Office Action, claims 2, 3, 22, 40, 41, 43, 62, 71, 76, 77, 81 and 82 were rejected under 35 U.S.C. § 102(b) as anticipated by Fischer. As discussed above, Fischer is directed to a system for supplying "to a centralized evaluator" data regarding channel selection and broadcast time in the embodiment illustrated in Fig. 2, or "a channel identification code and a program code" in the embodiment illustrated in Fig. 3. However, none of the embodiments disclosed by Fischer relate to "collecting ... use data associated with a recording fixed in a medium possessed by a user and identified by information obtained from contents of the recording used for playback to a user" (claim 2, lines 4-6).

Only the embodiment illustrated in Fig. 2 of Fischer discloses playback of a recording. As discussed above, what is recorded by video recorder 26 in Fischer is "the selected channel, the address of the location equipped with television set 3 and ... the number and personalia of viewers currently observing the TV-program" (column 4, lines 44-48). Fischer also notes that the "accumulated data can be accompanied by timing signals from a clock forming part of or connected to the processor 15" (column 4, lines 56-58). This is the only information that is available to be detected by photosensor 9 and sent "from the first device to the second device" (claim 2, line 8) via modem 6. In other words, the embodiment illustrated in Fig. 2 of Fischer sends information that identifies content only after reference to a program guide for what was broadcast on an identified channel at the time the program was received by the device in the home of the user. Information that identifies broadcast programs in this way is not "information obtained from contents of the recording used for playback to the user" (claim 2, lines 5-6).

As noted above, in the embodiment illustrated in Fig. 3 of Fischer, "a channel-identification code and a program code" (column 5, lines 54-55) are injected prior to transmission to the user's TV. Thus, in the embodiment illustrated in Fig. 3 of Fischer the modem sends information that is added solely for the purpose of being subsequently transmitted via the modem. The information is not "obtained from contents of the recording used for playback to the user" (claim 2, lines 5-6). The embodiment illustrated in Fig. 3 requires the addition of information prior to receipt of the recording by the user, so that use data can be collected. On the other hand, the present invention can be used to obtain use information regarding recordings that were distributed without any plan to later obtain use data. This is a significant benefit of the present invention, because there are a large number of recordings, such as compact discs and digital versatile discs (DVDs), as well as audio and video recordings in various tape formats that have been distributed without any such codes added. The present invention is able to obtain use data regarding recordings for which no one had the foresight to provide an identification code that could be transmitted with use data to a "second device via the network" (claim 2, lines 8-9) or a "centralized evaluator" (col. 4, line 8 of Fischer).

While the embodiment illustrated in Fig. 2 of Fischer does not require transmission of codes to the user to be used for identifying the content, this embodiment of Fischer only works for content that is broadcast according to a specific schedule. It can not be applied to recordings that are purchased by the user and played back at any time. The only recording that the system illustrated in Fig. 2 will work with is a recording made by the user of broadcast content. When a prerecorded tape is inserted into the video recorder, there will be no signal picked up by photosensor 9, unless the signal was inserted at the time that the recording was made. As discussed above, the present invention does not require foresight on the part of the publisher of the recording and is not limited to broadcast signals, because the information identifying the recording and use data associated therewith is "obtained from contents of the recording used for playback to the user" (claim 2, lines 5-6), not information identifying the channel and time of the broadcast content or codes that someone had the foresight to insert prior to receipt by the user.

All of the independent claims have been amended to recite limitations similar to those discussed above with respect to claim 2. Therefore, it is submitted that claims 2, 3, 22, 40, 41, 43, 62, 71, 76, 77, 81 and 82 patentably distinguish over Fischer for the reasons set forth above.

Rejection under 35 U.S.C. § 103

In item 3 on page 3 of the Office Action, claims 4-6, 16-19, 27, 28, 31-38, 44-47, 54-57, 63, 65-70, 72, 74, 78, 80 and 83-92 were rejected under 35 U.S.C. § 103 as unpatentable over Fischer in view of Kaplan '916. It is submitted that the addition of Kaplan '916 does not overcome the deficiencies of Fischer. First, it is noted that Kaplan '916 was filed on October 31, 1996 as a continuation-in-part of an application that resulted from repeated continuations of an application that issued as U.S. Patent 5,237,157 which was itself a continuation of an application filed on September 13, 1990. The Declaration under 37 C.F.R. § 1.131 filed October 6, 2000 established conception of the invention at least prior to July 28, 1996. Therefore, Kaplan '916 is not prior art and only the teachings of Kaplan '157 may be used in combination with Fischer.

Second, what is disclosed by Kaplan '157 is a system for previewing audio programs on compact discs at kiosk stations within a retail store. All of the recordings are identified prior to access by the customers at the store, as indicated by the display illustrated in Fig. 3. According to column 4, lines 40-41 of Kaplan '157, audio samples are apparently identified by a manual operation in which the samples are selected from music CDs. No suggestion has been found that the recordings are "identified by information obtained from contents of the recording used for playback to the user" (claim 2, lines 5-6). Since claims 4-6, 16-19, 31-38, 78 and 83 depend from claim 2 and the other claims rejected in item 3 depend from independent claims that have been amended to recite limitations similar to that quoted above from claim 2, it is submitted that claims 4-6, 16-19, 27, 28, 31-38, 44-47, 54-57, 63, 65-70, 72, 74, 78, 80 and 83-92 patentably distinguish over Fischer in view of Kaplan '157.

In item 4 on pages 3-4 of the Office Action, claims 7-15, 20, 21, 23-26, 39, 42, 48-53 and 58-61 were rejected under 35 U.S.C. § 103 as unpatentable over Fischer in view of Kaplan

'916 and further in view of Dedrick. It is submitted that the addition of Dedrick and Kaplan '916 does not overcome the deficiencies of Fischer. As noted above, Kaplan '916 is not prior art and therefore, Kaplan '157 has been substituted in its place. As also noted above, Kaplan '157 does not contain any teaching or suggestion that would suggest modification of Fischer to identify the recordings for which use data is collected, based on the contents of the recordings used for playback.

As discussed in the Amendment filed February 23, 2000, Dedrick is directed to a system for automatically updating a personal profile server with additional user information gathered from monitoring use of a computer based on data that is stored in a removable non-volatile storage device connected to the user's computer. There is no suggestion that the use data is related to any recording, let alone that the recording is identified based on contents that are used for playback to the user. Therefore, it is submitted that claims 7-15, 20, 21, 23-26, 39, 42, 48-53 and 58-61 patentably distinguish over the combination of Fischer, Kaplan '157 and Dedrick for the reasons set forth above.

New Claims

Claims 93-97 have been added to recite the invention more broadly than in the previously recited independent claims by not limiting the recording to a medium possessed by the user. However, like claim 2 discussed above, claims 93-97 clearly recite that the recording is identified by what is used to reproduce the recording, not supplementary information added solely to identify the recording. Therefore, it is submitted that claims 93-97 patentably distinguish over the prior art for the reasons discussed above.

Summary

It is submitted that the prior art references cited by the Examiner do not teach or suggest the features of the present claimed invention. Thus, it is submitted that claims 2-92 are in a condition suitable for allowance. Reconsideration of the claims and an early Notice of Allowance are earnestly solicited.

If any fees are required in connection with the filing of this Amendment, please charge same to our Deposit Account No. 19-3935.

Respectfully submitted,

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